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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,310	08/06/2001	Charles Han	000004	3087
23696 7590 04/18/2008 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121				
EXAMINER ELAHEE, MD S				
ART UNIT 2614		PAPER NUMBER		
NOTIFICATION DATE 04/18/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/924,310

Applicant(s)

HAN ET AL.

Examiner

MD S. ELAHEE

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9, 11-15, 18-22 and 27-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 9, 11-15, 18-22 and 27-41 is/are allowed.
- 6) ☒ Claim(s) 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB008)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-162)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 01/08/2008. Claims 1-5, 9, 11-15, 18-22 and 27-48 are pending. Claims 6-8, 10, 16, 17 and 23-26 have been previously cancelled. Claims 47 and 48 have been newly added.

Response to Arguments

2. Applicant's arguments filed on 01/08/2008 Remarks regarding claims 42-46 have been fully considered but they are not persuasive because of the following:

Regarding claims 42, 45, the Applicant further argues on page 15, that Hanson in combination with Motohashi does not suggest "providing a user with a first prompt for guidance when said feature of said wireless communication device has not previously been utilized". Examiner respectfully disagrees with the argument. Since the voice tag does not match with stored voice tag, it is clear that the feature for saving/dialing the voice tag has not previously been utilized, therefore the system prompts the user for guiding whether the user would like to get directory assistance (see fig.2, item 218). Thus the rejection of the claims in view of Hanson and Motohashi remain.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 47 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 47 recites a machine-readable medium comprising instructions, which, when executed by a machine, cause the machine to perform operations. Claim language does not comply with the requirements of MPEP 2106.01.I. The “medium” is only recited once in the invention disclosure (Preamble of Claim 47). Since “medium” is not defined in the disclosure, it may encompass a variety of media ranging from a piece of paper to a carrier signal. Furthermore, “computer program” or “software” is merely a set of instructions. On the contrary, “memory”, “computer program” and “software” are well defined acceptable terminology in computer programming. Additionally, comprising is not an acceptable linking word to associate “machine readable medium” to a “computer program”. Computer program is data structure. The claimed set of instructions is merely data structure. Data structures not claimed as embodied in computer-readable or machine-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer or machine. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held

nonstatutory). Claim 47 fails to include practical application that produces either (1) tangible, concrete and useful result or (2) physical transformation. Therefore, since the claimed machine-readable medium does not comprise instructions to cause a processor to perform the receiving, comparing, prompting, saving, checking and informing functions of the claim then the Applicant has not complied with 35 U.S.C 101.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 47 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 47, the phrase “the machine” in line 2 is indefinite. There are two different “machine”. It is unclear which “machine” is being referred to by the phrase.

Regarding claim 48, the phrase “the wireless communication device” in line 4 is indefinite. There are two different “wireless communication device”. It is unclear which “wireless communication device” is being referred to by the phrase.

Reasons for Allowance

5. Claims 1-5, 9, 11-15, 18-22 and 27-41 are allowed. Claim 47 will be allowed after overcoming rejections under 35 U.S.C. 101 and 35 U.S.C. 112, second paragraph. Claim 48 will be allowed after overcoming rejection under 35 U.S.C. 112, second paragraph.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 1 and 18, the prior art Foladare, Kitchings and Landell fail to teach prompting the user with a second prompt for a second voice tag corresponding to said first telephone number when said first voice tag corresponding to any telephone number has already been saved. There is no suggestion in Foladare's teaching to combine with the teachings of Kitchings and Landell to teach the limitation.

Regarding claims 29, 36, 47 and 48, the prior art Hanson, Kitchings and Motohashi fail to teach checking whether said voice tag is a first voice tag to be saved at the wireless communication device and saving the voice tag at the wireless communication device. There is no suggestion in Hanson's teaching to combine with the teaching of Kitchings and Motohashi to teach the limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claims 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (U.S. Patent No. 5,802,149) in view of Motohashi (U.S. Patent No. 6,351,639).

Regarding claim 42, Hanson teaches checking whether a voice tag saving or voice dialing feature [i.e., feature] of the wireless communication device has previously been utilized (fig.2, item 208) (Note: In col.3, lines 26-28, Hanson discloses that a voice-dialing system 107 provides users of telephone [i.e., wireless communication device] with voice dialing capability. Therefore, it is clear that the voice dialing feature is of the wireless communication device.);

providing a user with a first prompt for guidance when the feature of the wireless communication device has not previously been utilized (fig.2, item 218) (Note; since the voice tag does not match with stored voice tag, it is clear that the feature for saving/dialing the voice

tag has not previously been utilized, therefore the system prompts the user for guiding whether the user would like to get directory assistance); and

prompting the user with a second prompt for using the feature when the feature of the wireless communication device has previously been utilized (fig.3, item 248).

However, Hanson does not specifically teach wherein said checking is performed by said wireless communication device. Motohashi teaches wherein said checking is performed by the wireless communication device (col.19, lines 62-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hanson to incorporate the feature of performing said checking by the wireless communication device in order to perform checking locally at a caller's wireless device such that time spent in locally checking is reduced as compared to remotely checking.

Regarding claim 43, Hanson teaches that the first prompt for guidance is for making the user aware of the feature (fig.2, item 208; col.4, lines 5-10).

Regarding claim 44, Hanson teaches that the feature is selected from the group consisting of a number saving feature, a voice tag saving feature, a speed dialing feature, and a voice dialing feature (fig.2, item 206, fig.3, items 242,246,248).

Regarding claim 45, Hanson teaches matching [i.e., checking] whether a first voice tag dialing/saving feature [i.e., first feature] wireless communication device has previously been utilized (fig.2, item 210);

prompting a user [i.e., informing a user of an option] to use a second feature if the first feature of the wireless communication device has previously been utilized (fig.3, item 238; col.4, lines 34-38).

Regarding claim 46, Hanson teaches ending an operation of prompting for the second feature if the first feature of the wireless communication device has previously been utilized (fig.2, item 218).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fan Tsang/
Supervisory Patent Examiner, Art Unit 2614

/M.E./
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April 16, 2008